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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,997	12/20/2001	Gregory J. Wolff	015358-006800US	3773
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER ROSARIO, DENNIS	
			ART UNIT 2621	PAPER NUMBER

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/028,997	Applicant(s) WOLFF ET AL.	
	Examiner Dennis Rosario	Art Unit 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE 1/9/2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-27 and 29-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-25,27 and 29-77 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/2006 has been entered.

### ***Response to Amendment***

2. The amendment was received on January 9, 2006. Claims 1,3-27 and 29-77 are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1,17,18,24,25,27,45,46,52,54,57,71 and 72 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (US Patent 6,690,396 B1).

Regarding claim 18, Anderson discloses a method of generating a customized digital image, the method comprising:

a) receiving a first digital image (via the input of fig. 1,num. 106 as shown in fig. 2 via output arrow of fig. 1,num. 104);

b) analyzing the first digital image (Fig. 1, num. 106) by applying an image analysis technique (or “correlation” in col. 3, line 46 that identifies features, fig. 2, numerals 204-216.) to the first digital image to determine a first placement region (fig. 2,num. 204) on the first digital image for placing a second digital image (“3 X 5 PHOTOGRAPH” in fig. 2,num. 204 after scanning.);

c) placing the second digital image in the first placement region on the first digital image (fig. 3, num. 312 via a format operation) to generate the customized digital image (as shown in fig. 4,num. 402).

Regarding claim 19, Anderson discloses the method of claim 18 wherein the second digital image is a copy (or "thumbnail" in col. 5, line 58) of a third digital image (or "expanded view" in col. 5, line 58).

Claims 20 and 21 are rejected the same as claim 19. Thus, argument similar to that presented above for claim 19 is equally applicable to claims 20 and 21.

Regarding claim 22 see figure 1, numerals 102 and 104.

Regarding claim 23, Anderson discloses a "CCD" in col. 9, line 65.

6. Claims 17,45 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al. (US Patent Application Publication No.: US 2002/0040375 A1 or serial number 09/825,453).

Regarding claim 17 Simon et al. discloses a method of generating a customized digital image, the method comprising:

- a) receiving a signal (via the input of fig. 5,num. 110) comprising:
  - a1) digital signals representative of a plurality of digital images (as shown in fig. 5,num. 100);
- b) determining a template image (fig. 5,num. 110) from the plurality of digital images;
- c) determining one or more placement regions (fig. 17,num. 286) from the template image by applying an image analysis technique (via the method of fig. 7) to the template image, each placement region of the one or more placement regions identifying a location on the template image for receiving a digital image (as shown in fig. 15,num. 60) from the plurality of digital images;

d) identifying, for each placement region of the one or more placement regions, a digital image from the plurality of digital images to be placed in the placement region (as shown in fig. 15,num. 60); and

e) for each placement region of the one or more placement regions, placing a copy (Fig. 13,num. 62 is a copy relative to fig. 11,num. 62)) of a digital image from the plurality of digital images identified for the placement region in the placement region to generate the customized digital image (as shown in fig. 13).

Claim 45 is rejected the same as claim 17. Thus, argument similar to that presented above for claim 17 is equally applicable to claim 45 except for the limitation of:

- a) a processor (fig. 8,num. 802); and
- b) a memory (fig. 8,num. 804) coupled to the processor.

Claim 71 is rejected the same as claim 17. Thus, argument similar to that presented above for claim 17 is equally applicable to claim 71 except for the additional limitation disclosed in Simon et al. of a computer program product (fig. 1,num. 20).

7. Claims 1,3-16,18-25,27-44,46-70 and 72-77 is rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al. (US Patent 6,396,963 B2).

Regarding claim 1, Shaffer et al. discloses a method of generating a customized digital image, the method comprising:

- a) receiving a first digital image (via the inputs of fig. 7, num. 152);
- b) determining one or more placement regions (fig. 9 shows at the top left one placement region or the smaller rectangle enclosed by a larger rectangle) from the first digital image (top left larger rectangle) by applying an image analysis technique ("pattern recognition" in col. 13, line 13) to the first digital image, each placement region of the one or more placement regions identifying a location on the first digital image for placing a digital image from a first set of digital images (one image from fig. 7, num. 45);
- c) identifying (via fig. 7,num. 149), for each placement region of the one or more placement regions, a digital image from the first set of digital images to be placed in the placement region; and
- d) for each placement region of the one or more placement regions, placing a digital image (via fig. 6, label: "If new template, place proper picture into template." Note that fig. 6 is a digital version; thus all processing of figure 6 is digital.) from the first set of digital images identified (via fig. 7, num. 149) for the placement region (or layout of fig. 7,num. 157) in the placement region to generate the customized digital image (the output of fig. 7,num. 157.).

Regarding claim 3, Shaffer et al. discloses the method of claim 1 further comprising:

a) creating a link (or "list of images" in col. 13, line 22) between the customized digital image and at least one digital image ("high resolution image" in col. 13, line 23) from a second set of digital images (or "image storage" in col. 13, line 24), wherein the link enables access to the at least one digital image from the second set of digital images using the customized digital image (or "scanned layout sheets" in col. 13, line 26).

Claim 4 is rejected the same as claim 3. Thus, argument similar to that presented above for claim 3 is equally applicable to claim 4 except for requiring the limitation of a user as disclosed in Shaffer et al. via a "Customer" in fig. 7, num. 14.

Regarding claim 5, Shaffer et al. discloses the method of claim 1 wherein receiving the first digital image comprises:

a) scanning a paper medium on which the one or more placement region have been indicated to generate the first digital image (via the last step of fig. 5 (Analog version)).

Regarding claim 7, Shaffer et al. discloses the method of claim 1 wherein the one or more placement regions on the first digital image are indicated by one or more bounded regions (as shown by the smaller rectangles of fig. 9).

Regarding claim 8, Shaffer et al. discloses the method of claim 1 wherein the one or more placement regions on the first digital image are indicated by one or more text fragments (fig. 8, num. 119 or fig. 9, num. 164).



Claim 9 is rejected the same as claim 8. Thus, argument similar to that presented above for claim 8 is equally applicable to claim 9.

Regarding claim 12, Shaffer et al. teaches the method of claim 1 wherein identifying, for each placement region of the one or more placement regions, a digital image from the first set of digital images to be placed in the placement region comprises:

a) determining image identification information ( via "pattern recognition" in col. 13, line 13) associated with at least a first placement region of the one or more placement regions from the first digital image, the image identification information identifying an attribute ("embedded...data" in col. 12, lines 63,64) of a digital image to be placed in the at least first placement region;

b) identifying a first digital image from the first set of digital images to be placed in the at least first placement region based upon the image identification information (or "image identification" in col. 13, line 21) associated with the at least first placement region (via "image stickers" in col. 12, lines 61,62 that was placed in any one rectangle of fig. 9.).

Claim 11 is rejected the same as claim 10. Thus, argument similar to that presented above for claim 10 is equally applicable to claim 11.

Claim 12 is rejected the same as claim 10. Thus, argument similar to that presented above for claim 10 is equally applicable to claim 12 except for the additional limitation of a time stamp which is disclosed in Shaffer et al. in col. 11, line 66: "data and time" or "image identification" in col. 12, line 18 which is used for embedding into an image in col. 12, line 18-21.

Regarding claim 13, Shaffer et al. discloses the method of claim 1 wherein placing a digital image from the first set of digital images identified for the placement region in the placement region to generate the customized digital image comprises:

a) adjusting (or "zoom and crop" in col. 13, line 32) the digital image to fit the placement region.

Claim 14,15 and 16 are rejected the same as claim 13. Thus, argument similar to that presented above for claim 13 is equally applicable to claims 14,15 and 16.

Claim 18 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 18.

Claims 19 and 20 are rejected the same as claim 3. Thus, argument similar to that presented above for claim 3 is equally applicable to claims 19 and 20.

Claims 21 and 22 are rejected the same as claims 4 and 5. Thus, argument similar to that presented above for claims 4 and 5 is equally applicable to claims 21 and 22.

Claim 24 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 24 except for the additional limitation disclosed in Shaffer et al:

- a) capturing one or more images using a digital camera (fig. 2,num. 12);
- b) capturing a template image by scanning a paper medium (via fig. 7,num. 157).

Claim 27 are rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 27 except for the additional limitation disclosed in Shaffer et al.:

- a) an input module (the inputs of fig. 7,num. 152);
- b) a processing module (fig. 7,num. 152);
- c) wherein the input module is configured to receive a first digital image(via a scanner); and
- d) wherein the processing module is configured to perform the method of claim 1, addressed above.

Claims 29-31 and 33-42 are rejected the same as claims 3-5 and 7-16, respectively. Thus, argument similar to that presented above for claims 3-5 and 7-16 is equally applicable to claims 29-31 and 33-42, respectively.

Regarding claim 43, Shaffer at al. discloses a digital camera ("digital camera" in col. 13, line 37) that incorporates the system of claim 27.

Regarding clam 44, Shaffer et al. discloses a copying machine (or scanner of fig. 7,num. 157) that incorporates the system of claim 27.

Claim 46 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 46 except for the additional limitation disclosed in Shaffer et al.:

- a) a processor (fig. 4,num. 94); and
- b) a memory (fig. 4,num. 102) for storing a program;
- c) wherein the processor is operative with the program to:
  - c1) receive a first digital image; and
  - c2) receive a second digital image (via fig. 4,num. 104).

Claims 47-50 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claims 47-50.

Claims 52 and 54 are rejected the same as claim 46. Thus, argument similar to that presented above for claim 46 is equally applicable to claims 52 and 54.

Claims 55 and 56 are rejected the same as claims 43 and 44. Thus, argument similar to that presented above for claims 43 and 44 is equally applicable to claims 55 and 56.

Claim 57 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 57 except for the additional limitation as disclosed in Shaffer et al. of a computer program product (fig. 4,num. 102).

Claims 58-60 and 62-67 are rejected the same as claims 3-5 and 7-12, respectively. Thus, argument similar to that presented above for claims 3-5 and 7-12 is equally applicable to claims 58-60 and 62-67, respectively.

Claim 68 is rejected the same as claims 13 and 16. Thus, argument similar to that presented above for claims 13 and 16 is equally applicable to claim 68.

Claims 69 and 70 are rejected the same as claims 14 and 15. Thus, argument similar to that presented above for claims 14 and 15 is equally applicable to claims 69 and 70.

Claim 72 is rejected the same as claims 18 and 57. Thus, argument similar to that presented above for claims 18 and 57 is equally applicable to claim 72.

Claims 73-76 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claims 73-76.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6,23,25,32,51,61 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US Patent 6,396,963 B2) in view of Anderson (US Patent 6,690,396 B1).

Regarding claim 6, Shaffer et al. does not teach photographing a paper medium to generate the claimed first digital image, but does teach two methods (figures 5 and 6) of generating the claimed first digital image. Thus, Shaffer et al. suggests that there is a plurality of methods that can be used to generate the claimed first digital image.

Anderson et al. teaches another method of creating the claimed first digital image as shown in figure 2 and the additional limitation of:

a) photographing (via a "CCD...[or]...capture device" in col. 9, lines 65-67) a paper medium (or "TANGIBLE MEDIUM" of fig. 1,num. 102) on which the one or more placement regions have been indicated (as shown in fig. 2,num. 204) to generate the first digital image (fig. 2,num. 202).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Shaffer et al.'s two methods of figure 5 and 6 to generate the claimed first digital image with Anderson et al.'s teaching of using a CCD or capture device, because Anderson et al.'s teaching does not limit the types of devices and provides a plurality of devices for generating the claimed first digital image.

Claims 23,32,51,61 and 77 are rejected the same as claim 6. Thus, argument similar to that presented above for claim 6 is equally applicable to claims 23,32,51,61 and 77.

Claim 25 is rejected the same as claims 1 and 6. Thus, argument similar to that presented above for claims 1 and 6 is equally applicable to claim 25.

10. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US Patent 6,396,963 B2) in view of Anderson (US Patent 6,690,396 B1) further in view of Barret (US Patent 4,896,176 A).

Regarding claim 53 the combination of Shaffer et al. does not teach claim 53, but Anderson does teach that a "capture device" in col. 9, line 67 can be used, but does not provide enough details about the capture device.

Barret teaches a capture device as suggested by Anderson and claim 53:

a) a first button (fig. 1,num. 14) which when selected indicates that an image received by the digital camera is a template image (as shown in fig. 4).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Anderson et al. of the combination of the capture device with Barret's teaching of a capture device, because Barret supplies a teaching of a capture device that is missing in Anderson that would enable Anderson to create the claimed first digital image.

***Allowable Subject Matter***

11. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 26 is allowable because the art of record or the prior art does not teach or suggest the claimed button of a camera to capture an image of the claimed paper medium and to capture one or more images without selecting the claimed button.

The closest prior art is Barret (US Patent 4,896,176) that teaches a button (fig. 1,num. 14) to capture a template image and does not teach capturing another image without selecting the button (fig. 1,num. 14).


**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Rosario whose telephone number is (571) 272-7397. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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